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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,147	05/04/2001	Jacob J. Liu	56647USA8A.002	9714

7590 09/27/2002

Attention: Carolyn V. Peters  
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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 09/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 8/28/02.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-18 is/are pending in the application.
- Of the above claim(s) 15-18 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-14 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2, 4
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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1. Applicants' election with traverse of claims 1-14 in Paper No. 5 is acknowledged. The traversal is on the ground(s) that the claims are so interrelated that a search of one group of claims will reveal art to the other. Additionally, it is urged that the classification of the various claim groupings in different subclasses is not sufficient grounds to require restriction. This is not found persuasive because each group of claims has a different area of search and this, together with the classification of the claimed groupings in different subclasses clearly constitutes reasons for restriction.

The requirement is still deemed proper and is therefore made FINAL.

2. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicants regard as their invention.

3. Claims 2-11 and 14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, the dependent claims contain a significant number of informalisms and vague and indefinite statements. In claims 2 and 3 the phrase "styrene block" is not believed conventional terminology and a period is also missing from these claims. In claims 4, 5 and

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elsewhere the phrases "targeted surface" and "undesired surface", and in claim 6 the "surfaces include but are not limited to" are each found to be vague and indefinite in that they give no notice to a perspective infringer. In claim 9 "comprises" should be --comprise--. In claim 11, line 2 "preferred" is informal.

Claims 8 and 14 should use proper Markush language.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

5. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either EP 443263B1 or Bird. Note particularly EP

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-263 page 2 lines 3-5, lines 31-43, page 3 lines 8-31, lines 41-48, page 4 lines 1-35, the Examples, claims 1-10, particularly claim 4; Bird, the Abstract, column 3 lines 41-64, column 7 line 12 - column 9 line 60, column 12 lines 14-42. Each of the references discloses a repositionable genus of tapes which can be labels (EP -263) that comprise a low tack or tack-free elastomeric block copolymer based adhesive that appears to read upon, or at most be a minor modification thereof, of applicants' preferred genus of thermoplastic elastomeric block copolymers. Although Bird is directed primarily towards adhesive tapes and does not expressly teach the presence of a "label", the reference clearly teaches applicants' most preferred genus of repositionable non-pressure sensitive adhesives that comprise a thermoplastic block copolymer elastomer coated onto a suitable backing (column 12 lines 15-42). The Examiner further believes that the distinction of a "label" as opposed to an "adhesive tape" is usually at most only a distinction of whether or not the tape has been severed into segments, and <sup>also</sup> may well be directed to at most a patentably insignificant statement of intended use. Additionally, it is of course well within the ordinary skill of the art to sever into segments an adhesive tape. With respect to the claimed performance parameter regarding the storage modulus at room temperature which constitutes the Dahlquist criterion, such performance parameter is believed to be, if not expressly or

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inherently disclosed, at most an obvious modification to one of ordinary skill in the art in deciding upon <sup>what</sup> a suitable amount of adhesion or tack is desired. The remaining parameters are also believed to be, if not either expressly or inherently disclosed, obvious optimizations to one of ordinary skill, in the absence of unexpected results.

8. Claims 13 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either EP -263 or Bird. The references are again relied upon substantially as set forth above while the Examiner takes Official Notice that the ink receptive coating coated onto the first major surface is a well known property to those in the adhesive label and tape arts. Alternatively, note Popat et al., U.S. 5,316,344 at column 3 lines 9-15 which teaches that a wide variety of common label substrates such as paper, polyester film and the like may have a coating thereon to facilitate printing. What other parameters that may exist are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Josephy.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner

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can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

September 25, 2002

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP ~~4300~~  
1700

*Daniel Zinker*